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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,353	11/26/2001	Erik G. Burrows	2099A	9897

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EXAMINER

SORRELL, ERON J

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/994,353

**Applicant(s)**

BURROWS, ERIK G.

**Examiner**

Eron J. Sorrell

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1,4-8,11-15, and 18-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4,6-10,12-16 and 18 of copending Application No. 09/919,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of the

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instant application have a positive recitation of "receiving a selection of one of said available features from said list," whereas application 09/919,556 necessarily implies a reception of a selected feature in the limitation "analyzing a **selected feature** to be operable from said list (emphasis added)." A selection of a feature from a list of features would have to be received before analyzing a selected feature can take place.

The listed dependent claims are identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of independent claim 1 raises a question as to whether the claim is directed to merely an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject

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matter under 35 U.S.C. 101. It appears to the Examiner that the method of claim 1 can be implemented as a mental step or using a pencil and paper. It is suggested that language be added to indicate what elements are performing the limitations of the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1,2,4,5,8,9,11,12,15,16,18,19,22,23,25,26,29, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paxhia et al. (US Pub No. 2002/0065878 hereinafter "Paxhia") and view of Li et al. (WO 98/26548 hereinafter "Li").

7. Referring to method claim 1, program on readable medium claim 8, and system claims 15,29, and 30 Paxhia teaches a method and system, comprising:

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identifying hosts present within a local network (see paragraph 44 on page 2);

providing a list of available features for at least one host within said local network (see figure 7 and paragraphs 48-50 on page 3);

receiving a selection of one of said available features from said list (see paragraphs 48-50 and figure 8);

Paxhia fails to teach the limitations of analyzing if said selected feature requires a static IP address to be assigned to said at least one host and assigning an IP address to said at least one host, wherein a static IP address is assigned to said at least one host if said selected feature requires said static IP address, however Paxhia does teach one of the features is configuring the server as a Internet connection server.

Li teaches, in an analogous method, an Internet connection server requiring a static IP address and assigning an IP address to the Internet connection server (see lines 24-28 of page 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Paxhia with the above teachings of Li such that the system and method analyzes the selected feature to determine if a static IP address is required automatically and without user intervention. One of ordinary skill in the art

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would have been motivated to make such modification in order to ensure proper configuration of the Internet connection server as suggested by Li.

8. Referring to method claim 2, program on readable medium claim 9, and system claims 16 and 23, Li teaches that a dynamic IP address is assigned to the at least one host if the selected feature does not require a static IP address to be assigned to the at least one host (see 27-37 of page 2).

9. Referring to method claims 4 and 5, program on readable medium claims 11 and 12, and system claims 18,19,25 and 26, Paxhia teaches the list is provided in a graphical user interface and the selected feature is capable of being selected by a user utilizing the graphical user interface (see figure 7).

10. Referring to claim 22, Referring to system claim 22, Paxhia teaches, in a local network of one or more hosts, a system, comprising:

a processor (see item labeled 310 in figure 1);

a memory coupled to said processor, wherein said memory is capable of storing a list of available features for at least one host within the local network (see items 314-325 in figure 1);

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a display coupled to said processor, wherein said display is capable of providing said list of available features to a user (see paragraph 44 on page 2 and figure 7);

an input device coupled to said processor, wherein said input device is capable of receiving a selection by said user of one of said available features from said list (see paragraph 44 and 48-50 on pages 2 and 3); and

logic capable of being executed by the processor, wherein said logic is capable of identifying hosts present within a local network (see paragraphs 48-50 on page 3).

Paxhia fails to teach the limitations of analyzing if said feature selected by said user requires a static IP address to be assigned to said at least one host, and assigning an IP address to said at least one host, wherein a static IP address is assigned to said at least one host if said selected feature requires said static IP address.

Li teaches, in an analogous method, an Internet connection server requiring a static IP address and assigning an IP address to the Internet connection server (see lines 24-28 of page 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Paxhia with the above teachings of Li such that the system and method analyzes the selected feature to



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determine if a static IP address is required automatically and without user intervention. One of ordinary skill in the art would have been motivated to make such modification in order to ensure proper configuration of the Internet connection server as suggested by Li.

11. Claims 3,10,17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paxhia in view of Li as applied to claims 1,8,15, and 22 above and further in view of Wang et al. (U.S. Patent No. 6,496,511 hereinafter "Wang").

12. Referring to method claim 3, program on readable medium claim 10, and system claims 17 and 24, the combination of Paxhia and Li fails to disclose the limitation the static IP address being assigned from a pool of available static IP addresses and the dynamic IP address is assigned from a pool of available dynamic addresses.

Wang teaches, in an analogous system and method, the above limitation (see line 50 of column 2 to line 11 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Paxhia and Li with the above teachings of Wang. One of ordinary skill in the art would have been motivated to

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make such modification in order to reserve predetermined IP addresses in a fixed IP address pool for the uses to which they've been assigned as suggested by Wang (see lines 35-47 of column 2).

13. Claims 6,7,13,14,20,21,27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paxhia in view of Li as applied to claims 1,8,15, and 22 above and further in view of Chen et al. (US 2003/0028650 hereinafter "Chen").

14. Referring to method claim 6, program on readable medium claim 13, and system claims 20 and 27, the combination of Paxhia and Li fails to teach the assigning of the IP addresses in accordance with the Dynamic Host Configuration protocol.

Chen, in an analogous system, teaches the above limitation (see paragraph 80 on page 7).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Paxhia and Li with the above teachings of Chen. One of ordinary skill in the art would have been motivated to make such modification in order to efficiently utilize a sparse set of IP addresses which DHCP allows.

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15. Referring to method claim 7, program on readable medium claim and system claims 21 and 28, Chen teaches returning the static IP address to a pool of available IP addresses if said selected feature requiring the static address disabled (see paragraph 68 on page 6).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Paxhia and Li. One of ordinary skill in the art would have been motivated to make such modification in order to reuse the static IP address if later the feature is enabled again as suggested by Chen (see paragraph 68 on page 6).

16. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over of Paxhia in view of Li as applied to claims 1,8,15, and 22 above and further in view of Chupin et al. (US 2003/0222902 hereinafter "Chupin").

17. Referring to claim 31, the combination of Paxhia and Li fails to teach the list of available features includes blocking access to the Internet from said at least one host.

Chupin teaches, in an analogous system and method, the above limitation, and teaches that this is useful to block certain users for accessing content on the Internet that may be

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inappropriate for a particular user (see figure 7 and paragraph 32 on page 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify combination of Paxhia and Li with the above teachings of Chupin. One of ordinary skill in the art would have been motivated to make such modification in order to prevent particular users from accessing content on the Internet as suggested by Chupin (see paragraph 32 on page 3).

18. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paxhia in view of Li as applied to claims 1,8,15, and 22 above and further in view of Favier et al. (US 2002/0129142 hereinafter "Favier").

19. Referring to claim 32, the combination of Paxhia and Li fails to teach the list of available features includes designating the at least one host as a demilitarized zone (DMZ) host.

Favier teaches, in an analogous system, the above limitations (see paragraph 61 and 62 on pages 3 and 4). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the

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combination of Paxhia and Li with the above teachings of Favier. One of ordinary skill in the art would have been motivated to make such modification in order to allow a network administrator to easily configure the security components of a network through a GUI as suggested by Favier (see paragraph 29 on page 2).

### ***Response to Arguments***

20. Applicant's arguments with respect to claims 1,8,15, and 22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J. Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS

August 31, 2005



**KIM HUYNH**  
**PRIMARY EXAMINER**

9/1/05